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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,425	08/20/2003	Pierre-Yves Sibille	2002P13423 US01	6974

7590 11/14/2007
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EXAMINER

MOUTAOUAKIL, MOUNIR

ART UNIT	PAPER NUMBER
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2619

MAIL DATE	DELIVERY MODE
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11/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/644,425	Applicant(s) SIBILLE ET AL.	
	Examiner Mounir Moutaouakil	Art Unit 2619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 08-27-2007 has been entered and considered.

Claims 1-29 are pending in this application.

Claims 1-29 are rejected as indicated below.

Drawings

2. The drawing, Fig.1, is objected to because it represents the prior art (see background of the invention). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23, 24, and 29 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 22, the recitation of “ the overlayed private addressing scheme provides for inserting the control signal into the second signal so that the inserted control signal is operationally segregated within the public addressing scheme of the second protocol” is vague and indefinite because it is not known how the control signal is operationally segregated within the public addressing scheme of the second protocol. The paragraph that supports this limitation [0036] does not make this limitation clear. The metes and bounds of the claimed invention are not clear.

Regarding claim 24, the recitation of “extracting extracts the inserted control signal from the virtual addressing overlay” is vague and indefinite because it was never mentioned that a control signal is inserted into a virtual addressing overlay. The metes and bounds of the claimed invention are not clear.

Regarding claim 29, the recitation of “the addressing scheme” lacks antecedent basis.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims ^{21, 26 and 28}1-18_^ are rejected under 35 U.S.C. 102(b) as being anticipated by Subbiah (WO 2001/13599).

Regarding claims 1 and 12. Subbiah discloses a method for signaling a bearer connection coupled to a telecommunications network (page 6, lines 11-13), wherein the telecommunications network employs a first protocol (page 6, lines 17-18, the first protocol is ATM) and the bearer connection employs a second protocol (page 6, lines 19-20, the second protocol is IP), the method comprises the steps of mapping at least a portion of the first protocol to the second protocol (page 10, lines 9-19, and page 13, lines 1-9. The gateway is responsible for converting between the first signal and second signal without any problems); and inserting a first signal of the first protocol into a second signal of the second protocol according to the mapping (page 14, lines 1-8. the system inserts the signal from the first network to the second network, and vice versa), wherein the inserted first signal is employed in the control of the bearer connection (page 14, lines 1-23, the system is responsible for transferring the control information from the first protocol to the second protocol), wherein a portion of the second protocol is redefined as a private field to receive the

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inserted first signal (it is inherent that the second protocol has to provide a field to insert the first signal).

Regarding claims 2-7, 9, 13-17, 25 and 28. Subbiah discloses a method where the first protocol is an Internet protocol (the second protocol) and the second protocol is ATM protocol (the first protocol), wherein the step of mapping maps at least a portion of the Internet protocol to the ATM protocol (the system converts from the IP to ATM and vice versa, page 6, lines 11-13, lines 17-18, page 10, lines 9-19, and page 13, lines 1-9).

Regarding claim 8, Subbiah discloses a method where the step of mapping redefines a portion of the network prefix field (within the ATM address) following an authority and format identifier (see column 5, lines 5-19. IP packets are converted to ATM cells. Inherently, it is a designer's choice to modify and redefine the prefix field of the ATM address as long as it does not violate standard ITU or ATM Forum addressing rules).

Regarding claim 10 and 11, Subbiah discloses that the second protocol as a generic identifier transport (GIT) information element, where the step of translating translates the first signal into a signal suitable for insertion into the GIT information element, and mapping the first signal translated into a user data area of the GIT information element. (Inherently, the standard ATM cell structure indicates that GIT IE as part of the ATM cell. Moreover, user data area is part of the GIT IE. The person of ordinary skill in the art would know how to employ the GIT information element to carry translated elements from the first signal

associated with the first protocol and to map the first signal into a user data area of the GIT IE).

Regarding claim 18, Subbiah discloses a switch (gateway 600).

Regarding claim 21. Subbiah discloses a method for a bearer connection coupled to a telecommunications network, wherein the telecommunications network employs a first protocol and the bearer connection employs a second protocol (page 6, lines 10-20, the system interconnects ATM to IP and vice versa), the method comprises the steps of mapping a control signal of the first protocol formatted according to the first protocol to the second protocol (page 13, lines 1-5. the system converts signaling information from one network to another and vice versa), wherein a format for control signals of the first protocol differs from a format for control signals of the second protocol (ATM to IP and vice versa), at least in part; and inserting the control signal from the first protocol into a private field of the second protocol according to the mapping so that the mapped control signal is inserted according to the format for control signals of the second protocol (page 13, lines 1-5, page 14, lines 1-8. it is inherent that the system maps the control signal from a field in the first protocol to a an assigned field in the second protocol); and extracting from the second protocol, the inserted control signal wherein the extracted control signal dynamically controls (it is inherent that the receiving system would extract the inserted control signal to establish the communication channel), at least in part, establishment of the bearer connection (Fig. 7, 78, indicate the establishment of the bearer connection).

Regarding claim 26. Subbiah discloses that the first protocol is the IP and the step for mapping includes mapping session description protocol data into the second protocol (page 13, lines 1-4, where SIP includes SDP)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subbiah in view of Sen (US 2003/0112761).

Regarding claims 19 and 20. Subbiah disclosed all the limitations of claim 12.

The apparatus of Subbiah does not comprise an ingress and egress media gateways to initiate and terminate calls. However, Sen discloses a method of employing ingress media gateway (IMG) to initiate calls and egress media gateways (EMG) to terminate calls. Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to employ IMG and EMG to the telecommunication system of Subbiah. IMG and EMG are connected to the Ingress end user and egress end user respectively through TDM (see figure 1, and paragraph 23). The motivation for using the IMG and EMG of Sen into the telecommunication system of Subbiah being that it will terminate and initiate communication, depending on the control data received.

9. Claim 22 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subbiah in view of Chen et al (US 2004/0022250). Hereinafter referred to as Chen.

Regarding claims 22 and 27. Subbiah discloses all the limitations of the claimed invention. Subbiah does not explicitly disclose how the address of the first protocol is mapped into the second protocol, such as overlaying the addressing scheme of the first protocol over the addressing scheme of the second protocol. However, Chen teaches, in an IP/ATM interworking device, the capability to map the addressing information of the first protocol into the addressing field of the second protocol (paragraph [0048], [0097]). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to map the address of the first protocol into the address of the second protocol for the purpose of extracting the address at the final destination, which employs the first protocol as well, maintaining the address information.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

When responding to this office action, applicants are advised to clearly point out the patentable novelty which they think the claims present in view of the state of the art disclosed by the references cited or the objections made.

Applicants must also show how the amendments avoid such references or objections. See 37C.F.R 1.111(c). In addition, applicants are advised to provide the examiner with the line numbers and pages numbers in the application and/or references cited to assist examiner in locating the appropriate paragraphs.

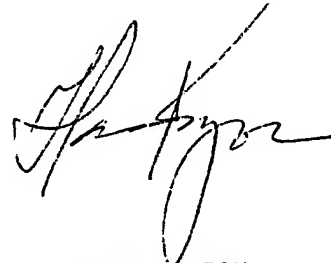
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mounir Moutaouakil whose telephone number is 571-270-1416. The examiner can normally be reached on Monday-Thursday (1pm-4: 30pm) eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MM
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Patent Examiner
11-01-2007



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